

Application No.: 09/682,329
Amendment dated: November 14, 2005
Reply to Office Action of June 14, 2005
Attorney Docket No.: 21295.0039

b.) Remarks

Claims 1-18 are pending in this application. Claims 1, 7 and 13 have been amended in various particulars as indicated hereinabove. Claims 2-5 and 14-17 have been canceled.

Turning now to the merits, Claims 1-18 were rejected under 35 U.S.C. 103(a) as over Jansson et al. (US Patent No. 4,672,559) in view of Katz et al. (US Patent No. 6,172,349). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

In the present case Jansson does not disclose identifying automatically a structure of interest from the data set and the selected position. Jansson also does not disclose the various image sensing parameters that can be adjusted to obtain a satisfactory image. In Col. 6, lines 43-65 Jansson discloses the operation of a mapping system, which is not the automatic selection step claimed in amended Claim 1.

Additionally, Jansson does not disclose an analytical operation based on the geometry of the structure of interest or on the data set of the structure of interest determined by means of pattern recognition, as claimed in amended Claims 1, 7, and 13.

Katz doesn't remedy the disclosure absent in Jansson. Katz only mentions an auto focusing apparatus of a microscope system. There is no disclosure in Katz of any other image acquisition parameter to be adjusted to obtain a satisfactory image, or of application of pattern recognition to the analytical operation.

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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Therefore, it is respectfully noted that neither Jansson nor Katz alone or in combination teach or suggest the invention as claimed in amended independent Claims 1, 7, and 13. Therefore, Applicant respectfully requests that the rejection be withdrawn and Claims 1, 7, and 13 be allowed.

Claim 6 depends off now allowable Claim 1 and is allowable. Claims 8-12 depend off now allowable Claim 7 and are allowable. Claim 18 depends off now allowable Claim 13 and is allowable.

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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